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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,454	10/27/2000	Miri Seiberg	JBP0518	5753

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EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,454

Applicant(s)

SEIBERG ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/30/04; 7/6/04; 4/21/05; 3/23/05</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Acknowledgment is made of the amendment filed 2/18/05. Claims pending are 15-22. Claims 16, 19 and 22 have been amended.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claim 22 is rejected under 35 U.S.C. 102(a) as being anticipated by Kelly et al. (WO 99/36050), supplied by the Applicant.

Kelly et al. teach using soy extract for protecting skin from UV damage. See Abstract. The soy extract of Kelly et al. is obtained by the extraction with a mixture of organic solvents and water. See p. 11, lines 23-27. The recitation of "non-denatured" soy product is inherent in the reference because the soy beans are extracted without using enzymes and/or temperature. The compositions of Kelly et al. may also contain preservatives. See p. 10, lines 8-9.

Thus, Kelly et al. teach each and every limitation of Claim 22.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokuyama (JP 5-320061), translation of which supplied by the Applicant, in view of Mizue (JP 62-36304), of record.

Tokuyama teaches using aqueous or organic extract of soy beans and/or other legumes in unaltered form in topical dermatological compositions for treating a variety of skin diseases and conditions such as scratches, cuts, burns, rashes, eruptions, pimples, blackheads, chapping skin, eczema, dermatitis, etc. See Abstract; [0009]; [0010]; [0033]; table 4; [0035]. Moreover, the soy bean extracts applied to the skin as cosmetic products showed "a smoothing effect on the texture of the skin", "a wrinkle stretching rejuvenating effect", skin softening and moisturizing effect and "an aging preventing effect". See [0045]-[0047]. With respect to Claim 17, the compositions of Tokuyama have a "beautifying effect" on the skin, i.e. inhibit tyrosinase activity. See [0048]. (Please note that the term "beautifying effect" is often used in Japanese publications as synonymous to "skin whitening effect"). With respect to Claim 20, the reference teaches inhibiting sebum production. See [0035]; [0045]. With respect to Claim 21, Tokuyama teaches "smoothing effect on the texture of the skin" and anti-aging effect. See [0045]. With respect to the limitation "non-denatured", the Tokuyama reference teaches the same extraction method as disclosed in the instant application. See Examples 2 and 3. Therefore, the soy product of Tokuyama is inherently non-denatured. The Tokuyama reference does not explicitly teach the stabilizing system of

the instant claims. However, Mizue teaches stabilizing soy extracts in cosmetic compositions with preservatives such as parabens and chelating agents such as disodium EDTA. See p. 6 of the translation; Examples. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cosmetic or dermatological soy extract-containing compositions of Tokuyama such that to add chemical agents such as preservatives. One having ordinary skill in the art would have been motivated to do this to prevent spoilage of the soy extract as suggested by Mizue.

Response to Arguments

5. Applicant's arguments with respect to claims 15-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary L. Kunz
GARY KUNZ
SUPERVISORY PATENT EXAMINER
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6/10/05